

### **Remarks and Arguments**

Claims 1-20 are pending in this application. Claims 3-8, 11, 17 and 18 have been withdrawn from consideration as being allegedly drawn to a non-elected species. Claims 1 and 19 have been amended to particularly point out the invention. Support for these amendments is found in the specification in Figures 8 and 9. Claims 9, 10, and 12 have been amended to merely correct a typographical error. Claims 1-20 stand rejected. Each of the rejections is addressed below.

#### **Anticipation Under 35 U.S.C. § 102(b)**

##### **1. The Anticipation Standard**

The standard required for finding anticipation under 35 U.S.C. § 102(b) is stated in MPEP § 2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). ‘The identical invention must be shown in as complete detail as is contained in the...claim’. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).”

##### **2. Claims 1, 10, and 12**

Claims 1, 10, and 12 stand rejected as allegedly anticipated by U.S. Patent No. 5,824,059 (hereinafter “Wijay”). The Office alleges that Figures 1, 2, and 5 in Wijay disclose a stent body having a plurality of adjacent circumferential support structures including longitudinal struts and apex portions, the apex portions forming junctions between adjacent longitudinal struts, some of the apex portions of adjacent circumferential support structures being configured to overlap one another and circumferential connecting struts.

Claim 1 as amended herein recites: “a plurality of circumferential connecting struts interconnecting a plurality, but not all of the adjacent circumferentially disposed support structures.” Claims 10 and 12 depend on claim 1. Applicants submit that Wijay does not disclose this element of the invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **3. Claims 19 and 20**

Claims 19 and 20 stand rejected as allegedly anticipated by U.S. Patent No. 5,449,373 (hereinafter, "Pinchasik"). The Office alleges that Pinchasik discloses a stent body having a plurality of adjacent circumferential support structures, including longitudinal struts interconnected at apex portions, and circumferential connecting struts interconnecting only some of the adjacent circumferential support structures wherein some pairs of adjacent circumferential support structures have apex portions that oppose one another and other pairs of adjacent circumferential support structures have apex portions that are offset by the circumferential connecting struts.

Claim 19 as amended herein recites: "a plurality of circumferential connecting struts interconnecting a plurality, but not all of the adjacent circumferentially disposed support structures." Claim 20 depends on claim 19. Applicants submit that Pinchasik does not disclose this element of the invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **Obviousness Under 35 U.S.C. § 103**

#### **1. The Obviousness Standard**

MPEP § 2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations."

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 947, F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP § 2142. The PTO has not met its burden in the instant case.

## **2. Claims 1, 10, and 12**

Claims 1, 10, and 12 stand rejected as allegedly obvious in light of Wijay, discussed above. As stated previously claim 1 as amended recite : “a plurality of circumferential connecting struts interconnecting a plurality, but not all of the adjacent circumferentially disposed support structures.” Claims 10 and 12 depend on claim 1. Wijay does not disclose this element of the invention. The Office has failed to establish a prima facie case of obviousness because the cited reference does not teach or suggest all of the claim limitations. Accordingly, Applicants respectfully request withdrawal of the rejection.

## **3. Claim 2**

Claim 2 stands rejected as allegedly obvious in light of Wijay. The Office admits that Wijay fails to clearly show adjacent circumferential support structures in the embodiments shown in Figures 1, 2, and 5, but nonetheless the Office alleges that the embodiments shown in Figures 3 and 4 show that adjacent circumferential support structures should be offset such that the apex portions on one side of a support structure are positioned intermediate apex portions on a facing side of an adjacent support structure. The Office alleges that it would have been self evident that this arrangement would provide better support to the blood vessel around its circumference. Applicants note that the Office has cited no reference to support its position in this regard. Applicants call upon the Office to cite a reference to support its position or alternatively provide an affidavit under 37 C.F.R. 104(d) if the Examiner is relying on personal knowledge.

Claim 2, depends on claim 1. Applicants submit that claim 2 is not obvious in view of Wijay in light of the amendment to claim 1 set forth above. Wijay does not disclose a plurality of circumferential connecting struts interconnecting a plurality, but not all of the adjacent circumferentially disposed support structures, thus the Office has not established a prima facie case of obviousness. Applicants respectfully request withdrawal of the rejection.

#### **4. Claims 9 and 13-16**

Claims 9 and 13-16 stands rejected as allegedly obvious in light of Wijay combined with Pinchasik. Regarding claim 9, the Office admits that Wijay fails to disclose the circumferential connecting struts joining first and second support structures extending in a first direction and the circumferential connecting struts joining second and third support structure extending in a second direction, but alleges that Pinchasik discloses that the circumferential connecting struts should alternate in their direction to minimize rotational displacement.

Regarding claim 13, the Office admits that Wijay fails to disclose the circumferential connecting members located between only some of the adjacent pairs of circumferential support structures, but alleges that Pinchasik teaches that some of the adjacent pairs of circumferential support structures of a stent should be directly attached to one another.

Claims 9 and 13-15 depend on claim 1. Applicants submit that claims 9 and 13-15 are not obvious in view of Wijay, combined with Pinchasik in light of the amendment to claim 1 set forth above. Neither reference discloses a plurality of circumferential connecting struts interconnecting a plurality, but not all of the adjacent circumferentially disposed support structures, thus the Office has not established a prima facie case of obviousness. Applicants respectfully request withdrawal of the rejection.

Regarding claim 16, the Office admits that Wijay and Pinchasik fail to disclose three consecutive circumferential support structures being interconnected by circumferential connecting members, nonetheless, the Office alleges that it was well known in the art to arrange three consecutive circumferential support structures of a stent to be interconnected by circumferential connecting members provide flexibility to the stent when being inserted through tortuous blood vessels. The Office also suggests that these "well known art statements," are taken to be admitted prior art because the Applicant failed to traverse the Examiner's assertion in the last amendment. First, Applicants note that they did traverse the rejection (see page 8, paragraph 1, Amendment dated February 23, 2004). Secondly, Applicants note that the last paragraph of the Amendment dated February 23, 2004 stated: "Although certain arguments regarding patentability are set forth herein, there are many other arguments

and reasons why the claimed invention is patentably distinct. Applicant reserves the right to raise these arguments in the future.” Thus Applicants never surrendered the right to challenge the unsubstantiated positions relied upon by the Office in supporting any rejection. Lastly, MPEP provides specific guidance regarding when common knowledge may be relied upon. MPEP §2144.04 E. states:

Any rejection based on assertions that a fact is well known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in Ahlert, any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without any evidentiary support in the record as the principal evidence upon which a rejection was based (emphasis added).

Applicants note that the common knowledge relied upon by the Office in rejecting claim 16 is not insubstantial. It goes to the very heart of the claim. Moreover, the sole basis of the rejection is the alleged “common knowledge.” The Office admits that neither cited reference supports the rejection. Applicants call upon the Office to cite a reference to support its position or alternatively provide an affidavit under 37 C.F.R. 104(d) if the Examiner is relying on personal knowledge or else withdraw the rejection.

## CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Applicant believes the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, the Examiner is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §§1.16 and 1.17 to Deposit Account No. 02-3038.

Respectfully submitted,



Date: 8/16/2005

Paul D. Sorkin, Esq. Reg. No. 39,039

KUDIRKA & JOBSE, LLP

Customer Number 021127

Tel: (617) 367-4600 Fax: (617) 367-4656